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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,872	11/15/2000	Michael Bleser	29488/36478	7661
4743	7590	04/06/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			PORTER, RACHEL L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,872	BLESER ET AL.	
	Examiner	Art Unit	
	Rachel L. Porter	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152). |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 6/17/06. Claims 1-16 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, it is unclear to the Examiner how the “so” clause modifies or further limits the present claim, and whether/how it is modifies the functionality of the application server. As currently recited, the phrase seems to be an intended use of the system as a whole, rather than a function of a particular element of a system component. In other words, the function of the application server “is connected to connected to at least a plurality of pharmacies and one or more pharmacies...,” “configured to allow each of the one or more customers to access information concerning drugs and personal information... and enable each of the customers to transmit a prescription...” The so-clause does not recite a function performed by intranet server, and therefore it is unclear how it further limits the current claim or the functions of the system components.

Claims 2-8 inherit the deficiencies of claim 1 through dependency and are also rejected.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9, 11-12, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Szabo (USPN 5,954,640).

[Claim 1] Szabo teaches a system for accessing pharmacy data and ordering prescriptions via a network comprising:

- a network server connected to the network that is accessible by one or more customers via the network; (Figure 1; Web server (10))
- an application server connected to the network server; (Figure 1, Application server (15))
- a database connected to the application server, the database containing information concerning drugs and personal information concerning one or more of the customers; and (Figure 1; database 11-14)

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- an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, the intranet server being connected to the application server; (col. 9, lines 46-54—data sent to pharmacists/medical professionals; col. 10, lines 51-62; col. 14, lines 8-16—users may connect pharmaceutical information of different vendors)
- wherein the application server is configured to allow a customer to access the information concerning drugs and personal information concerning that customer and enable each of the one or more customers to transmit a prescription order to at least one of the plurality of member pharmacies or one of the one or more shipping facilities (Figure 1; col. 8, lines 5-19; col. 12, lines 51-62; col. 13, lines 24-42—Application server performs optimization, allows user to evaluate a proposed purchase on a health optimization, and helps link patient to purchasing system for order placement.)

[Claim 2] Szabo the system as defined in claim 1, wherein the network server displays one or more interactive webpages to the one or more customers that is viewable by the one or more customers with a respective network browser. (col. 6, lines 26-40; col. 11, lines 31-37; col. 12, lines 28-44).

[Claim 3] Szabo teaches a system wherein the personal information concerning the one or more customers includes a prescription history of each respective one of the one or more customers. (col. 7, lines 62-col. 8, line 4)

[Claim 4] Szabo teaches the system as defined in claim 3, wherein the network server is configured to format display of the prescription history of each respective one of the one or more customers according to a plurality of selectable display formats that are selected by the respective one of the one or more customers. (Figure 3; col. 6, lines 26-35; col. 12, lines 35-61)

[Claim 5] Szabo teaches system wherein the network server is configured to allow each respective one of the one or more customers to print each particular selectable display format of the prescription history that is selected by the respective one or the one or more customers. (col. 6, lines 43-47; col. 12, lines 35-61)

[Claim 6] Szabo teaches a system wherein the network is the Internet. (col. 13, lines 37-42)

[Claim 7] Szabo teaches a system wherein access to personal information concerning each respective customer of the one or more customers includes at least one of access and viewing of the personal information, editing of the personal information and adding additional information to the personal information previously stored.

[Claim 8] Szabo teaches a system as defined in claim 1, wherein the prescription order includes at least one of ordering a new prescription (i.e. recommendation from the

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optimization), or refilling an existing prescription. (col. 15, lines 5-14; col. 16, lines 27-39)

[Claim 9] Szabo teaches method enabling one or more customers to order prescriptions and access pharmacy data via a network comprising the steps of:

- accessing a network server hosting a network website via the network; (Figures 1-2)
- registering a customer with the network website; (Figure 2; col. 13, lines 43-67)
- displaying to the customer on the website at least one of a prescription order selection or a pharmacy data access selection; (col. 14, lines 11-16; col. 15, lines 5-14)
- displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities; and (col. 10, lines 51-62; col. 16, lines 8-14)
- displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database. (col. 16, lines 16-26)

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[Claim 11] Szabo teaches a method, wherein the personal prescription history includes one or more of current prescriptions and past prescriptions (col. 13, lines 44-67; col. 16, lines 15-26—e.g. medical conditions and treatments)

[Claim 12] Szabo teaches a method as defined in claim 9, wherein the particular prescription order includes one of a new prescription order or a refill of an existing prescription. (col. 15, lines 5-14; col. 16, lines 27-39)

[Claim 15] Szabo teaches a method further comprising the steps of:

- enabling the customer to select one or more display formats for the personal prescription history; and (Figure 3; col. 6, lines 26-35; col. 12, lines 35-61)
- enabling a customer to print a specific format selected by the customer from the one or more display formats. (col. 6, lines 43-47; col. 12, lines 35-61)

[Claim 16] Szabo teaches a method wherein the particular prescription order includes a selectable designation by the customer to communicate that the prescription will one of a) be manually picked up at a selected pharmacy store location; and b) be shipped to a designated postal address. (col. 6, lines 47-56; col. 10, lines 51-62; col. 15, lines 5-14—System allows the prescribed treatment to be purchased a retail facility (i.e. pharmacy store location or through the mail.)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo as applied to claim 9, and in further view of Mayaud (USPN 5,845,255 A).

[Claim 10] Szabo teaches a prescription ordering method including the step of registering customers as explained in the rejection of claim 9. Szabo further discloses a method wherein the step of registering the customer further comprises the steps of:

- prompting the customer to enter a username and personal profile information; (col. 13, lines 43-67)
- transmitting and storing an entered username and personal profile information to/in a network server; (Figure 1—personal storage database ; col. 13, lines 30-37)
- enabling the customer to access at least portions of the website by subsequent entry of the entered username (Figure 3; col. 16, lines 15-39)

Szabo discloses the method above, but does not expressly disclose the use of passwords as part of the user access system. Mayaud discloses a prescription creation/file access system wherein the individuals submitting prescriptions and accessing the patient profiles use passwords (col. 10, lines 12-51). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to

modify the method of Szabo with the teaching of Mayaud to include the use of passwords to access profiles and/or submit prescriptions. As suggested by Mayaud, one would have been motivated to include this feature to further protect sensitive patient information, (col. 10, lines 24-27) and to provide an audit trail of individuals accessing the system (col. 18, lines 62-65)

8. Claim 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Szabo as applied to claim 9, and in further view of Official Notice.

[Claim 13] Szabo teaches a method as defined in claim 9 as explained in the rejection of claim 9. Szabo further discloses a method requiring the use of personal profile information and other identifying information to access the system, but does not expressly disclose the use of PIN numbers to access to access the system. However, it is noted that the use of generated PIN numbers or personal codes as a security measure to access a system (e.g. website, telephone system) is old and well known in the art. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method Szabo to include the use of generated PIN numbers to access secured portions of the site. One would have been motivated to include this feature to further protect sensitive patient information and minimize fraudulent charges made against the customer.

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[Claim 14] Szabo teaches a method as defined in claim 9, wherein the step of registering the customer further comprises:

- manually entering a username and a customer personal profile concerning the customer into a connection to an intranet server located in one of any one of a plurality of member pharmacies and one or more centralized company locations; (col. 6, lines 12-25)
- associating the customer in a network server (col. 6, lines 26-35)

Szabo discloses the method as disclosed above, but does not disclose the step of communicating at least a username and password, which enable the customer to access the network website, to the user via a secured communication. However, it is noted that confirmation messages providing registered users with information on the username and secondary identification information (e.g. password or PIN's) are old and well known in the art. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Szabo to provide confirmation messages to registered users, including their username and secondary identifying information (i.e. password/ PIN). One would have been motivated to include this information to ensure that the customer has properly registered for the system and to facilitate his/her access to the system.

Claim 14 has been amended to recite manually entering patient contact information. Szabo discloses the method as disclosed above, but does not expressly disclose the step of the user manually entering contact information. However, Szabo does disclose shipping orders to the user. (col. 10, lines 58-62) At the time of the

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Applicant invention, it would have been obvious to one of ordinary skill in the art to gather contact information from the user with the motivation of ensuring that the order reaches the proper destination. (col. 10, lines 58-62)

Response to Arguments

9. Applicant's arguments filed 1/17/06 have been fully considered but they are not persuasive.

(A) On page 7, applicant traverses the 112, 2nd paragraph rejection regarding the "so-clause" in claim 1.

In response, the Examiner has added language in an attempt to clarify the perceived problem with the current claim language, but has maintained the rejection.

Also, it is noted that claim 1 has been amended, apparently to overcome other 112, 2nd issues raised in the Office Action mailed 9/12/05. These issues have been withdrawn in light of the amendments filed 1/17/06.

(B) Applicant argues that the prior art (Szabo) does not disclose an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities and is purely a Web-based system.

In response, the Examiner respectfully disagrees the Applicant's interpretation of the Szabo reference. Szabo discloses the incorporation of pharmacies and medical professionals using the disclose (Szabo) system (col. 6, lines 12-25; col. 9, lines 46-54)

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Szabo discloses incorporation of shipping facilities (col. 16, lines 8-15 (specifically lines 10-12)).

As to applicant's assertion that the Szabo system is only a Web-based system, and does not include an intranet server, Szabo discloses that the system functions over the Internet, but is not limited to the Internet (col. 12, lines 62-67—includes local computer, network, client-server environment, etc.). Furthermore, the Examiner understands an "intranet" to be a network, which is designed for access by a limited group or organization. However, it is not a network that precludes the Internet and the use of the World Wide Web. Insofar as the Szabo reference provides network access and services to registered users (e.g. recognized users—see Figures 2-3), it is an intranet that uses the Internet. The fact that the system's servers are communicatively linked and can transmit the required data via the network (col. 10, line 58-66; col. 13, lines 24-42) (e.g. an order to a vendor) requires that they are "connected" to the shipping facility. As such, the Web implementation of the Szabo system addresses the intranet server feature of applicant's claim.

(C) Applicant argues that Szabo does not disclose an applicant server that is "configured to allow a customer to transmit a prescription to at least one of the plurality of member pharmacies or one of the shipping facilities..."

In response, Applicant argued in the response to the 112, 2nd rejection the "configured to allow" claim language was not vague and indefinite and in response, the Examiner has withdrawn the 112, 2nd rejection regarding the "configured to allow" language. However, the current claim language remains broad and as such, the

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Examiner has given the claim the broadest reasonable interpretation and maintained the prior art rejection. As currently recited, a server that is “configured to allow a user to...” perform a function may be broadly interpreted as one which *allows* a user to login, or one which *allows* to open an application. In other words, the current claim language need only facilitate the functions that follow.

Moreover, regarding the “so-clause,” the Examiner has maintained the 112,2nd paragraph rejection regarding this recitation. Accordingly, the Examiner has interpreted the claim language as best as possible and applied art accordingly. As explained in the 112,2nd paragraph rejection in the present Office Action, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Furthermore, Szabo discloses a system wherein the application server is configured to allow a customer to access the information concerning drugs and personal information concerning that customer and enable each of the one or more customers to transmit a prescription order to at least one of the plurality of member pharmacies OR one of the one or more shipping facilities (col. 8, lines 5-19; 10, lines 58-66; col. 12, lines 51-62; col. 13, lines 24-42—Application server performs optimization, allows user to evaluate a proposed purchase on a health optimization, and helps link patients to a vendor (e.g. shipping facility) to have orders shipped to them.)

It should be noted that the current claim language is written in the alternative (i.e. the order is transmitted to either the member pharmacies OR the shipping facilities. Moreover, the Examiner has broadly any entity that ships materials as a "shipping facility." If the Applicant has a specific definition for the term "shipping facility," then the definition should be pointed in the originally filed disclosure and/or incorporated into the claim language.

(D) On pages 10-11 of the response filed 1/12/06, applicant argues that limitations of claim 9, primarily as they relate to claim 1.

In response, the arguments of claim 9 are addressed by the responses to the arguments regarding claim 1.

(E) On page 11, applicant argues that combination of Szabo, Mayaud and Official Notice does not render the claims 10 and 13-14 obvious as there is no motivation to combine in the references.

Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the Examiner has provided citations from the references and/or logical explanation to support a holding of obviousness and to explain why one of ordinary skill in the art would have been motivated to modify the references and propose the applied combinations in the rejected claims at the time of the applicant's invention. Moreover, the test for obviousness is not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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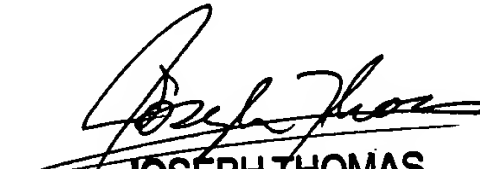
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER